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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,220	08/03/2001	Israel Rubinstein	U 013579-0	8917
140 7590 04/02/2007 LADAS & PARRY 26 WEST 61ST STREET NEW YORK, NY 10023			EXAMINER ALEXANDER, LYLE	
			ART UNIT 1743	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE 3 MONTHS		MAIL DATE 04/02/2007	DELIVERY MODE PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/922,220

Applicant(s)

RUBINSTEIN ET AL.

Examiner

Lyle A. Alexander

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1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 213-330 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 213-330 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1122107
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 213-263 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Aussenegg et al., Schalkhammer et al. or Mayer Ch. et al..

All of these references teach method of sample analysis where the sample is adsorbed on a metal island, electromagnetic radiation is transmitted through the sample/island and the subsequent deviations in absorption are correlated to the identity of the sample.

Claims 213-219 and 222- 330 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Schalkhammer et al.

See the appropriate paragraph of the 7/11/06 Office action.

Claim Rejections - 35 USC § 103

Claims 220-221 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schalkhammer et al.(USP 5,866,433).

See Schalkhammer et al. supra.

Schalkhammer et al. is silent to using a monochromator.

White et al. (USP 6,750,065) column 5 lines 32-43 teaches surface plasmon measurements can be made using less expensive light sources such as a lamp with a monochromator grating or prism to select the appropriate frequency.

It would have been within the skill of the art to modify Schalkhammer et al. in view of White et al. and use a lamp and monochromator as a light source to create a less expensive piece of equipment.

Response to Arguments

Applicant's arguments filed 1/16/07 have been fully considered but they are not persuasive.

On page 26 Applicants state '433 requires "a certain analyte-specific fluorescent compound...". The instant claim language is open and does not exclude use of additional compounds.

Applicant's state '433 does not perform the limitation (a) of claim 263 "(a) contacting the sample ... conductive material,". These remarks are not understood because "433 teaches in the abstract "... the biorecognition layer being directly applied on the island layer or bound via a spacer film ".

Applicant also states '433 uses the fluorescence measurements for a different purpose than the instant invention. These remarks are not commensurate in scope with the pending claims that only require the measurement of fluorescence which is clearly taught by the '433 patent.

Applicant's state '433 does not teach use of a laser. The '433 patent teach use of a laser in column 3 line, 23 and lines 51-54.

With respect to the teachings of a monochromator, this limitation has been addressed above.

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Applicants' state '433 does not "... utilize an external source ..." and "light transmitted through the structure does not pass through the sample ...". The Office does not know what "external source" Applicant is referencing. The Office maintains '433 teach transmitted light through the sample for the optical measurement.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lyle A Alexander
Primary Examiner
Art Unit 1743

